R E M A R K S

The Examiner's comments in the April 8, 2004, Office Action have been carefully considered. Applicant notes with appreciation the apparent allowability of Claims 14-16 and 17 if re-written in independent form. Such changes in claim dependencies have been proposed in the above amendments. Entry of such amendments and an allowance of Claims 14-16 and 17 are respectfully requested.

In addition, Applicant respectfully requests reexamination of the present Application in view of the following remarks and the preceding amendments.

Examiner's Rejections

Claims 6, 7, and 17 have been objected to based upon certain identified informalities. Claims 1-2 and 8-10 stand rejected under 35 U.S.C. 103 as unpatentable over Benjamin (U.S. Patent No. 3,613,694) in view of Miller (U.S. Patent No. 4,106,515). Claims 3-7 and 11-13 are rejected under 35 U.S.C. 103 as being unpatentable over Benjamin in view of Miller, and in further view of Sessoms (U.S. Patent No. 1,385,722). Claims 11-13 have been rejected as being the reverse structure of rejected Claims 3-7, and the reversal is alleged to involve only routine skill.

Status of Claims

Claims 1-17 remain in this application. Claims 6 and 17 have been amended to address the identified informalities. Claim 14 has been amended to place it in independent form.

Applicant's Response - Claim Informalities

Applicant appreciates the efforts of the Examiner in identifying certain informalities. Claims 6 and 17 have been

amended to address the ambiguities identified by the Examiner, and entry of these corrective amendments is respectfully requested.

Section 103 Rejections

Claims 1-2, 8-10: Benjamin v/o Miller

Section 2143 of the Manual of Patent Examining Procedure ("MPEP") identifies three requirements to establish a prima facie case of obviousness: (1) some suggestion or motivation to modify or combine the reference(s); (2) a reasonable expectation of success; and (3) the prior art reference(s) must teach or suggest all claim(s) limitations. The overriding rational for all three limitations is to avoid the temptation of a hindsight analysis.

Benjamin discloses an eyeglasses sideburn trimmer, and the Examiner correctly identifies the lack in Benjamin of a "pegs" disclosure. The Examiner offers Miller as providing the missing teaching for the use of pegs in a side burn trimming guide - specifically, on page 3 of the Action:

> Miller discloses a peg (shaft 24) attached to a frame and projecting therefrom so it can fit through an aperture (slit 32) of a trim guide (template 28), as discussed in column 2, lines 7-23.

The structure identified as a peg or shaft is in fact a threaded shaft. Completion of the Miller fastening unit requires

> Means 38 such as an internal threaded nut or a wing nut are provided to lock the template 28 about the shaft 24. (Col. 2, Lines 22-24).

Use of a true "peg" would present problems to the Miller side burn trimmer, since a true "peg" - template arrangement would

permit the template 28 to freely slide the vertical length of the slit 32.   In fact, such a replacement would render the Miller device "unsatisfactory for its intended purpose" of providing "an even and accurate cut" of a user's side burns.

Section 2143.01 of the MPEP and In re Gordon, 733 F.2d 900 (Fed. Cir. 1984) both caution that when a proposed modification of a prior art invention would render the invention being modified unsatisfactory for its intended purpose, there can be no suggestion or motivation to make the proposed modification. A key attribute of the Miller templates 28 is their slit 32 that, in combination with the threaded shaft 24 and retaining nut 38, permit easy adjustment in side burn length.   In such a combination, a peg might enable easy adjustment, but without being able to secure its relative position along the slit 32, such a peg would offer no assurance of maintaining an accurate measurement.

Accuracy is key to Miller (as well as all side burn trimming guides), and thus to so modify Miller would destroy its primary intended purpose.   Under such circumstances, such a proposed modification of Miller is not proper, and the prima facie case of obviousness can not be properly made.

Claims 3-7 and 11-13 Benjamin v/o Miller v/o Sessoms

For the reasons discussed above, Miller cannot be used to establish a prima facie case of obviousness in the Benjamin/Miller/Sessoms combination asserted by the Examiner in relation to Claims 3-7 and 11-13.   The teachings of Sessoms do not supply the missing motivation, nor does Sessoms support a separate basis for modifying Benjamin to achieve Applicant's claimed invention.

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The Sessoms device is not a side burn trimming guide - instead in hangs from the user's ears to guide the trimming of the back of the neck. In Figure 8 Benjamin already provides teachings for adjustable trimming guides in a non-eyeglasses configuration. There is no suggestion or motivation in either Benjamin or Sessoms to forge a sideburn trim guide as defined by Applicant's Claims 3-7 and/or 11-13.

Conclusion

In view of the foregoing arguments, it is respectfully submitted that the Office Action of April 8, 2004, fails to establish a _prima facie_ case of obviousness. Applicant hereby requests withdrawal of the rejections under Section 103(a).

The fees required for an Extension of Time accompany this Amendment. If there are any questions or other issues that might be resolvable by a telephone call with Applicant's counsel, the Office is invited to place same at the number indicated below.

Respectfully submitted,

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Dated: 9 Aug 2004

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